



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,625	05/02/2001	Luis A. Rovira	A-6671	5607

5642 7590 04/20/2005

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER

LAYE, JADE O

ART UNIT PAPER NUMBER

2614

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/847,625		ROVIRA, LUIS A.	
	Examiner		Art Unit	
	Jade O. Laye		2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendments, filed 2/16/05 have been entered and made of record. Claims 1-35 are rejected. In view of Applicant's amendments to the Claims and Specification, objections detailed in the previous action have been withdrawn.

Response to Arguments

2. Applicant's arguments filed 2/16/05 have been fully considered, but are considered unpersuasive.

Applicant argues that *Ellis*'s future programs are not "scheduled to be publicly broadcast at a later time." This argument is unpersuasive for three reasons: (1) Applicant fails to effectively advocate exactly what is the distinction between "broadcast" and "publicly broadcast," (2) Applicant's Specification provides no support for such a distinction, and (3) the disclosure of *Ellis* does in fact teach the amended limitation. Below, the Examiner will provide support for each.

First, Applicant fails to effectively advocate the distinction between "broadcast" and "publicly broadcast." As discussed in the Examiner's previous non-final rejection, *Ellis* teaches providing a user with an IPG (which displays a television program schedule) identifying a future program scheduled to be broadcast (i.e., publicly broadcast) at a later time (Pg. 1, Ln. 4-7 & Pg. 13, Ln. 7-10), receiving user input requesting said future television program (Pg. 3, Ln. 7-10), and providing said future television program prior to said later time. (Pg. 26, Ln. 4-7). It is not

Art Unit: 2614

clear what distinction Applicant is attempting to make by the addition of “publicly,” therefore, the Examiner is unable to specifically rebut any interpretation asserted by the Applicant. However, the Examiner will rebut the broadest reasonable interpretation below.

Secondly, Applicant’s specification provides no support for such a distinction. On page 10, Line 25 of Applicant’s Specification, a future television program is defined as “a media presentation or event that is scheduled to be broadcast at a later time...[which is] stored at a headend 11 until requested by a user.” Applicant then goes on to state that a future television program “...may be delivered using a VOD delivery method, a NVOD delivery method, a Pay Per View delivery method, or some other delivery method.” (Pg. 11, Ln. 11-13). Nowhere does Applicant provide support for distinguishing “publicly broadcast” from “broadcast.”

Thirdly, the amended limitation is encompassed within the disclosure of *Ellis* because the Examiner finds no distinction between “broadcast” and “publicly broadcast.” Since Applicant provides no supporting interpretation, the Examiner gives “publicly broadcast” its broadest reasonable interpretation – to be broadcasted to the public. Given this interpretation, the teaching of *Ellis* still anticipates. *Ellis*’s system does in fact publicly broadcast programs because the programs are broadcasted to the public. For example, any subscriber can request the future program in advance of its original scheduled broadcast time, thus said future program is available to the public.

Lastly, in the event Applicant intends “publicly broadcast” to mean *the program is provided prior to a later scheduled broadcast time in which it will be available to non-subscribers*, the Examiner asserts this final argument. The Examiner takes Official Notice that it is notoriously well-known in this art for newly released programs to be available on VOD, Pay-

Art Unit: 2614

Per-view, or any other similar systems before they are available as non-pay television broadcasts (i.e., available before it is scheduled to be available to non-subscribers). This enables movie companies and content providers to receive additional profit. For example, *Ellis* Figure 8, discloses the *Truman Show* being offered immediately in November of 1999 (PCT publication date), while “thestranger.com” reference shows the Truman Show being publicly available on NBC in February of 2001. (http://thestranger.com/2001-02-08/love_tv.html) This, in essence, shows an IPG displaying a future television program, said future television program scheduled to be publicly broadcast (i.e., broadcast to non-subscribers) at a later time as recited in Applicant’s amended claim 1. Therefore, even under this interpretation, *Ellis* anticipates claim 1.

Specification

3. The amendment filed 2/16/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant argues that the distinction between “publicly broadcast” and “broadcast” is a patentably distinct feature of the claimed invention. However, the Specification provides no support for such an interpretation nor does it provide support for such a distinction.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 7, 8, 10-12, 18-20, 25, 26, 28, 29, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellis (WO 99/60790).

As to claim 1, Ellis discloses:

- a. providing a user with an interactive program guide (page 1, Ln. 4-7)
identifying a future television program (page 13, Ln 7-10).
- b. receiving user input requesting a television program (page 3, Ln. 7-10)
- c. and providing said future program prior to its later scheduled *publicly* broadcast time (page 26, Ln 4-7) in response to a user request.

Accordingly, each and every limitation of claim 1 has been anticipated by *Ellis*.

As to claim 3, Ellis further discloses charging a user a fee in connection with the provision of programs. (page 13, Ln. 18-20). Accordingly, each and every limitation of claim 3 has been anticipated by Ellis.

As to claim 7, Ellis further discloses an IPG which list information pertaining to program titles, times, channels, and descriptions. (page 3, Ln. 1-3). Accordingly, each and every limitation of claim 7 has been anticipated by Ellis.

As to claim 8, Ellis further discloses an IPG, which utilizes a remote control device in order to display program information and to display the later schedule programs. (page 3, Ln 5-9). Accordingly, each and every element of claim 8 has been anticipated by Ellis.

As to claim 10, Ellis further discloses an IPG in which television programs are received from a broadcasting network or i.e., content provider. (Page 1, Ln. 11-13). Accordingly, each and every limitation of claim 9 has been anticipated by Ellis.

As to claim 11, Ellis discloses a method of storing a video on demand program within a home storage device (page 24, Ln. 4-9). Accordingly, each and every limitation of applicant's claim 11 has been anticipated by Ellis.

Claim 28 is an apparatus claim corresponding to the method claim 11, and is analyzed and rejected as previously discussed.

As to claim 12, Ellis further discloses an IPG system, which stores programs in devices capable of being connected, i.e., coupled, to a set-top box, i.e. client device. (Page 15, Ln. 28-32). Accordingly, each and every limitation of claim 12 has been anticipated by Ellis.

As to claim 18, Ellis further discloses an IPG, which provides user with access to current television programs (page 13, Ln. 10). Accordingly, each and every limitation of claim 18 has been anticipated by Ellis.

Claims 19, 20, 25, 26, 29 and 35 are apparatus claims corresponding to the method claims 1, 3, 7, 8, 12, and 18 respectively. Accordingly, claims 19, 20, 25, 26, 29 and 35 are analyzed and rejected as previously discussed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Kostreski (US #5,534,912).

Applicant's claim 2 recites a method of confirming a user's authorization to receive a television program. As discuss above, Ellis discloses an IPG system, which contains all limitations of applicant's claim 1, but fails to teach the use of any method of authorization. Within the same field of endeavor, Kostreski teaches a means for indicating which channels are authorized to a user. (Col 8, Ln. 3-22).

Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the IPG of Ellis with the authorization means of Kostreski in order to provide an efficient mechanism for verification.

Claim 22 is an apparatus claim corresponding to the method claim 2, and is analyzed and rejected as previously discussed.

6. Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis.

Applicant's claim 4 recites a method of charging a user a fee in connection with providing access to future programs. As discussed in paragraph 5 above, Ellis discloses a method of charging a user a fee in connection with the "provision" of a later scheduled program, but fails to teach a method of charging said user a fee in connection with providing "access" to said programs.

It would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to modify the billing method of Ellis to also include charging the user for having "access" to the future television programming. Charging a fee for access to a program is an obvious variant of charging a fee for the provision of the program, thereby allowing the content provider an additional avenue of charging a user.

Claim 21 is an apparatus claim corresponding to the method claim 4, and is analyzed and rejected as previously discussed.

7. Claims 5, 6, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Matthews, III (US #5815145).

Applicant's claim 5 discloses an IPG which contains a table corresponding to individual episodes of a given future television program. As discussed above in paragraph 5, Ellis discloses all limitations of claim 1, but fails to disclose an IPG containing a episode database. Within the same field of endeavor, Matthews, III, discloses an IPG database containing episodes corresponding to television programs. (Col. 7, Ln 48-49). Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the

Art Unit: 2614

IPG of Ellis with the episode database of Matthews III in order to provide a more detailed and extensive program list for the user to choose from.

Claim 23 is an apparatus claim corresponding to the method claim 5, and is analyzed and rejected as previously discussed.

As to claim 6, Ellis further discloses that the programs listed in the IPG could be sit-coms or dramas, but fails to specifically list whether programs could be soap-operas. (Page 18, Ln. 20-21). However, claim 6 recites a Markush Group, which are anticipated if it is shown that one alternative is contained within the prior art. Accordingly, each and every limitation of claim 6 has been anticipated by Ellis. (Moreover, the examiner would like to note that soap operas are considered to be an obvious variant of a sit-com or drama, which were combined to provide a more exhaustive listing and would be rejected accordingly.)

Claim 24 is an apparatus claim corresponding to method claim 6, and is analyzed and rejected as previously discussed.

8. Claims 9, 15, 16, 17, 27, 32, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Girard et al. (US # 5,751,282).

Applicant's claim 9 recites the method of claim 1, wherein the future television program is received from a headend. As discussed above in paragraph 5, Ellis teaches all limitations of applicant's claim 1, but fails to specifically state that the program can be received from a headend. Within the same field of endeavor, Girard teaches a video signal being received from a head end. (Col. 3, Ln 8-10). Accordingly, it would have been obvious to one ordinarily skilled

in this art at the time of applicant's invention to combine the IPG of Ellis with the headend teaching of Girard in order to provide a multi-tier distribution structure.

Claim 27 is an apparatus claim corresponding to method claim 9, and is analyzed and rejected as previously discussed.

Applicant's claim 15 recites the method of claim 1, wherein the future program is stored in a device located inside a cable television system. As discussed above in paragraph 5, Ellis contains each limitation of applicant's claim 1, but fails to specifically disclose whether a storage device is located inside a cable television system. Within the same field of endeavor, Girard discloses a program storage device, which is contained within a cable television system. (Fig. 1). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the IPG of Ellis with the storage device of Girard in order to provide an alternative method of storing said future programs.

Claim 32 is an apparatus claim corresponding to the method claim 15, and is analyzed and rejected as previously discussed.

Applicant's claim 16 recites a method of claim 1, wherein the future program is stored in a device coupled to a cable television system. As discussed above in paragraph 5, Ellis contains each limitation of applicant's claim 1, but fails to specifically state whether a storage device is coupled to a television system. Within the same of field of endeavor, Girard discloses that the program storage device is contained within or, i.e., coupled to, a cable television system. (Fig. 1). Accordingly it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the IPG of Ellis with the cable system storage teaching of Girard in order to provide an alternate method of storing said future programs.

Applicant's claim 17 recites the method of claim 1 wherein the user is provided with access to previously broadcasted television programs. As discussed above in paragraph 5, Ellis teaches each limitation of applicant's claim 1, but fails to specifically discuss providing access to previously broadcasted television programs. Within the same field of endeavor, Girard teaches the user's access to previously broadcasted television programs. (Col. 2, Ln. 19-21 & 30-32). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify the IPG of Ellis to further provide access to previously broadcasted programs in order to provide the user with a wider selection of programs to choose from.

Claims 33 and 34 are apparatus claims corresponding to the method claims 16 and 17, respectively. Accordingly, they are analyzed and rejected as previously discussed.

9. Claims 13, 14, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Gordon et al. (US #5,682,597).

Applicant's claims 13 and 14 recite methods of storing said television programs in either a hub or node, respectively. As discussed in paragraph 5 above, Ellis contains each limitation of applicant's claim 1, but fails to specifically state whether programs can be stored in hubs or nodes. Within the same field of endeavor, Gordon teaches the use of hubs and nodes, which are used to store video programs. (Col. 1, Ln. 65-68). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the IPG of Ellis with the hub and node storage teaching of Gordon in order to provide alternate methods of storage.

Claims 30 and 31 are apparatus claims corresponding to method claims 13 and 14, respectively. Accordingly, they are analyzed and rejected as previously discussed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JL

April 15, 2005.



NGOC-YEN VU
PRIMARY EXAMINER